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Atty. Dkt. No. ROC920010110US1

REMARKS

This is intended as a full and complete response to the Office Action dated December 20, 2004, having a shortened statutory period for response set to expire on March 20, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-27 are pending in the application. Claims 1-27 remain pending following entry of this response. Claims 1, 3, 8, 14, and 19 have been amended. Claims 1, 14, and 19 have been amended to clarify the invention. Claims 3, 8 and 19 have been amended to correct minor problems. New claims 28-32 have been added. New claims 28, 29, and 32 contain the content of claims 8, 23, and 26 rewritten in independent form with corresponding dependent claims. Examiner previously stated that claims 8, 23, and 26 and the claims that depend therefrom would be allowable if rewritten in independent form. Thus, Applicants respectfully submit that new claims 28-32 are allowable. Applicants submit that the amendments and new claims do not introduce new matter.

35 U.S.C. § 102(b) Rejections

Claims 1-7, 11, 12, 19, 21 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Katz et al.* (US 5,926,624, hereinafter "*Katz*"). Applicants respectfully traverse the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim... *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Katz* does not disclose "each and every element as set forth in the claim". Specifically, with respect to amended claims 1, 14, and 19, and the claims that depend therefrom *Katz* does not disclose responding with placement information, wherein the placement information comprises hardware installation information

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pertaining to the installation of a specified hardware device. The sections of *Katz* cited by the Examiner in the previous action (Col. 8, Lines 5-63) only describes a library server (Item 260, Fig. 2) which delivers digital information files to a requesting client computer system (Item 214, Fig. 2). Col. 8, Lines 32-40. The digital information consists of content from sources such as books, educational sources, speech materials, and other audio or visual materials. See Col. 5, Lines 46-60. The digital information may be played on a mobile playback device. See Item 212, Fig 2; Col. 5, Lines 21-32. Thus, *Katz* describes the delivery of multimedia files which are used solely for playback or display on a mobile playback device. Col. 5, Lines 46-60; Col. 5, Lines 21-32. Accordingly, *Katz* does not describe responding with placement information, wherein the placement information comprises hardware installation information pertaining to the installation of a specified hardware device.

35 U.S.C. § 103(a) Rejections

Claims 9, 10, 13, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Katz* as applied to claims 1 and 19 above, further in view of *Valencia* (US 5,918,019, hereinafter "*Valencia*"). Applicants believe *Katz*, as applied to claims 1 and 19, has been overcome. Thus, Applicants submit that the combination of *Katz* and *Valencia* has also been overcome. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Katz* in view of *Valencia*. Again, Applicants respectfully submit that *Katz* has been overcome. Accordingly, Applicants submit that the combination of *Katz* and *Valencia* has also been overcome. Also, Applicants respectfully request that the Examiner reconsider claim 14 in light of the fact that claim 8 is objected to but otherwise allowable, since claim 14 appears to include the language of claim 8 that the Examiner seems to have based the allowability of claim 8 upon. Withdrawal of the rejection is respectfully requested.

Examiner commented on minor problems observed in the claims. Specifically, in claims 3 and 14, the claim referred to "the internet" and as opposed to "the Internet". In claim 8, it appeared that text was missing between the words "wherein" and

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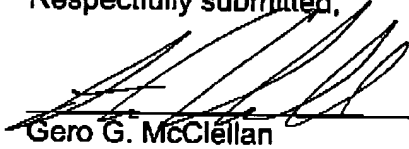
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"configuration". The claims have been amended to correct the minor problems. Claims 3 and 14 have been amended to replace "the internet" with "the Internet". Claim 8 has been amended to insert "the" between "wherein" and "configuration". Accordingly, allowance of the claims is respectfully requested.

Claims 8, 18, 23, 24, 25 and 26 are objected to as being dependent upon a rejected base claim. As described above, claims 8, 23, and 26, and the claims that depend therefrom have been rewritten in independent form in corresponding claims 28, 29, and 32. Accordingly, allowance of the new claims is respectfully requested. Further, regarding claim 18, Applicants submit that the rejection of the corresponding base claim (claim 14) has been overcome. Accordingly, withdrawal of the objection is respectfully requested.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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